

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Final Official Action, the Examiner objected to the title of the invention as not being descriptive. The Examiner suggested a new title for the invention: A Light Source Device for an Endoscope Using a DMD. The Title has been amended in the present Preliminary Amendment as suggested by the Examiner.

In the Final Official Action, the Examiner rejected claims 2 and 3 under 35 U.S.C. §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. In particular, the Examiner states that claims 2 and 3 redundantly recite the “function of the mirror control circuit (i.e., controlling the plurality of micromirrors based on a signal).” Further, the Examiner states, “that what the signal is “based on” or represents does not structurally change the mirror control circuit.”

In response, Applicants respectfully submit that the controller is novel and distinctly claimed in regard to the functional aspects of the claimed mirror control circuit. Applicants submit that a controller able to carry out the recited functions is novel over controllers, which do not contemplate such functions. Thus, Applicants respectfully request that the Examiner reconsider the rejection of claims 2 and 3 under 35 U.S.C. §112, second paragraph

In the Official Action, the Examiner rejects Claims 1-5 under 35 U.S.C. §102(e) as being anticipated by US Patent No. 6,464,633 issued to Hosoda, et al. (Hosoda). Additionally, claims 1-5 were rejected under 35 U.S.C. §102(b) as being anticipated by US Patent No. 6,128,077 issued to Jovin, et al. (Jovin). Claims 6 and 8-10 were rejected under 35

U.S.C. §103(a) as being unpatentable over Hosoda. Claims 11-16, 18 ad 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoda in view of US Patent No. 4,887,153 issued to Uehara, et al. (Uehara).

In response, independent claim 1 has been amended to include the features of dependent claim 6 (as well as intervening claim 4). Independent claim 11 has also been amended to include the features of dependent claim 6. Accordingly claims 4, 6, and 16 have been canceled so as not to be redundant. Dependent claim 6 (as well as dependent claim 16) are currently rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoda.

As discussed by the Examiner, the Hosada reference has been assigned to Olympus Optical Co. Ltd., therefore, under 35 U.S.C. § 103(c) the subject matter of the Hosada reference shall not preclude patentability under 103(a) when at the time the invention was made it was subject to an obligation of assignment to the same person. The present invention was assigned to Olympus Optical Co. Ltd., and was under such an obligation at the time of filing. Thus, since the cited references were assigned to Olympus Optical Co. Ltd., at the time the present invention was made, the Hosada reference cannot be used in a 35 U.S.C. § 103(a) rejection. Hosada is prior art only under one or more of subsection 102(e), (f), and (g).

The instant application was filed on February 28, 2002. Under the *Guidelines to the Implementation of Changes to 35 USC 102(g) and 103(c) and the Interpretation of the Term "Original Application" in the American Inventors Protection Act of 1999*, Notice, 1233 OG 2 (April 11, 2000), the present application is entitled to the benefit of 103(c) (see, subsection II(A)(1)).

According to the *Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)*, 1241 OG 96 (Dec 26, 2000), the statement of an attorney or agent of record asserting common ownership at time the instant invention was made is sufficient evidence to disqualify the reference (see, section III, *Modified Policy on Evidence to Establish Common Ownership or an Obligation for Assignment to the Same Person*).

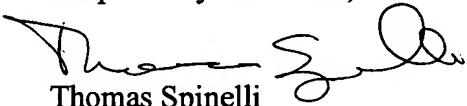
The Undersigned hereby states that both the instant application and U.S. Patent No. 6,464,363 to Hosada, et al. were, at the time the invention of the instant application was made, owned by or subject to an obligation of assignment to Olympus Optical Co. Ltd. A copy of this statement is being submitted on a separate sheet attached hereto.

Accordingly, the Applicants respectfully submit that the Hosada reference is improper and should not bar the patentability of at least claims 6 and 16 under 35 U.S.C. § 103(a). As discussed above, independent claims 1 and 11 have been amended to include the features of claim 6. Accordingly, Applicants respectfully submit that independent claims 1 and 11 are allowable and that claims 2, 3, 5, 8-10, 12-15, 18, and 19 are at least allowable therewith as depending from an allowable base claim (claims 4, 6, and 16 being canceled).

Lastly, in the Final Official Action, the Examiner rejected claims 1-3 and 5 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,464,633. Applicants respectfully request that the Examiner reconsider such a rejection in light of the present amendment of claim 1 to include the features of dependent claim 6 and intervening claim 4.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli  
Registration No.: 39,533

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343

TS:cm  
Enclosure